

REMARKS

Applicants submit this Reply in response to the non-final Office Action mailed October 28, 2008. Claims 17 and 19-38 are currently pending, of which claims 17 and 36 are independent. In this response, Applicants have only amended dependent claim 19 to correct its dependency on independent claim 17. In the non-final Office Action dated October 28, 2008, the Examiner objected to claim 19 and rejected claims 17, 20, 21, 32-34, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,456,847 ("Lilja et al.") in view of U.S. Patent No. 7,151,933 ("Chen et al."). The Examiner rejected claims 22, 23, 24-31, 35, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Lilja et al. in view of Chen et al. and further in view of U.S. Patent No. 6,940,827 ("Li et al."). Applicants respectfully traverse the pending claim objection and rejections and request reconsideration of the application, as amended.

Claim Objection

The Examiner objected to claim 19 because "the claim dependency is based on a canceled claim." Office Action dated October 28, 2008, at 2. In this response, Applicants have amended dependent claim 19 to correct its dependency on pending independent claim 17 rather than on canceled claim 18. In view of this amendment, Applicants submit that the objection to claim 19 should be removed.

Rejections Under 35 U.S.C. § 103(a) of Independent Claims 17 and 36

The Examiner rejected independent claims 17 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Lilja et al. in view of Chen et al. To establish a *prima facie* case of obviousness, "All Claim Limitations Must Be Considered." M.P.E.P. § 2143.03 (8th ed., rev. 6, Sept. 2007). More specifically, the M.P.E.P. requires that "[a]ll words in

a claim must be considered in judging the patentability of that claim against the prior art." *Id.* (*quoting In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970)). In this case, Lilja et al. and Chen et al., whether considered individually or in combination, fail to disclose or suggest every element of Applicants' invention.

Independent claim 17 calls for a combination including, for example, "a type of radio access used by at least one base radio station providing the packet data transmission service in the at least one macrocell is updated to support the multi-carrier radio access used in the at least one microcell." Independent claim 36 similarly recites, among other things, "updating at least one base radio station providing the packet data transmission service from using the first type of radio access to using the multi-carrier radio access." Applicants submit that neither Lilja et al. nor Chen et al., whether considered individually or in combination, disclose or suggest at least "a type of radio access used by at least one base radio station . . . is *updated*" as recited in claim 17, or "*updating at least one base radio station*" as recited in claim 36.

The Examiner acknowledges that Lilja et al. fails to disclose or suggest at least "a type of radio access used by at least one base radio station . . . is updated" as recited in independent claim 17, or "*updating at least one base radio station*" as recited in independent claim 36. See Office Action dated October 28, 2008, at 8-9 ("Lilja '847 discloses all the claimed limitations with the exception of being silent about the claimed

features . . .").¹ To remedy these acknowledged deficiencies in Lilja et al., the Examiner instead argues that "Chen '933 from the same field of endeavor discloses the above [missing] claim features." Office Action dated October 28, 2008, at 9. Applicants respectfully disagree and submit that Chen et al. fails to disclose or suggest at least the same above-noted claim recitations missing from Lilja et al. Accordingly, there is no reasonable combination of Lilja et al. and Chen et al. that can legally anticipate or render obvious every element of Applicants' independent claims 17 and 36.

Chen et al. discloses a "method of handoff within a telecommunications system containing digital base stations with different spectral capabilities." Chen et al., Title. More specifically, Chen et al. discloses a "hand-off from a set of narrowband compliant base stations to at least one wideband compliant base station while a remote station is in the coverage area of both types of base stations." Chen et al., Abstract. For example, FIG. 5 in Chen et al. illustrates different points "x," such as points 520, 528, 540, and 548, where a remote station is in the coverage of different base stations and a base-station handoff can occur. See, e.g., Chen et al., col. 11, ll. 1-23; col. 12, ll. 1-20.

When describing the base-station handoff procedure, Chen et al. discloses two different types of base stations: "a single carrier system (base stations labeled BS1) and a multi-carrier system (the base stations labeled BS3)." Chen et al., col. 9, ll. 63-66. FIGS. 4-5 in Chen et al. illustrate predefined coverage areas for each of the

¹ The Office Action contains a number of statements reflecting characterizations of the claims and related art. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action. For example, while Applicants agree that Lilja et al. is missing elements recited in independent claims 17 and 36, Applicants do not agree with the Examiner's characterization that "Lilja '847 discloses all the claim limitations with the exception of" certain missing claim elements.

single-carrier base stations BS1 and multi-carrier base stations BS3. Importantly, Chen et al. does not appear to disclose or suggest that a single-carrier base station BS1 can be updated to provide multi-carrier radio access, e.g., thereby converting the single-carrier base station BS1 to a multi-carrier base station BS3.

While Chen et al. discloses various embodiments of a base-station handoff procedure for passing radio access between single-carrier and multi-carrier base stations, Chen et al. fails to further disclose or suggest at least “a type of radio access used by at least one base radio station . . . is updated to support the multi-carrier radio access used in the at least one microcell,” as recited in independent claim 17, or “updating at least one base radio station providing the packet data transmission service from using the first type of radio access to using the multi-carrier radio access,” as recited in independent claim 36.

The base-station handoff procedure in Chen et al. is concerned with passing radio access from a first base station to a second base station. Indeed, the Examiner's cited portions of Chen et al. discuss various points in FIG. 5 where the coverage areas of adjacent base stations overlap and thus a handoff can occur. See, e.g., Chen et al., col. 11, ll. 1-23; col. 12, ll. 1-20. The Examiner characterizes the base-station handoff as “switching from single carrier to multi-carrier services.” Office Action dated October 28, 2008, at 10. While the radio access at the mobile station in Chen et al. may switch from a single-carrier system (BS1) to a multi-carrier system (BS3), Chen et al. does not additionally disclose or suggest updating the type of radio access used at a base radio station to support multi-carrier radio access. To the contrary, the single-carrier base stations BS1 in Chen et al. always provide single-carrier radio access, and the multi-

carrier base stations BS3 always provide multi-carrier radio access. The base-station handoff procedure in Chen et al. appears to be completely silent regarding updating a single-carrier base station BS1 to instead provide multi-carrier radio access.

Because Lilja et al. and Chen et al. each fails to disclose or suggest updating a type of radio access at a base radio station, these cited references, whether considered alone or in any reasonable combination, likewise fail to disclose or suggest at least "a type of radio access used by at least one base radio station . . . is updated to support the multi-carrier radio access used in the at least one microcell," as recited in independent claim 17, or "updating at least one base radio station providing the packet data transmission service from using the first type of radio access to using the multi-carrier radio access," as recited in independent claim 36. For at least the reasons discussed above, Applicants submit that independent claims 17 and 36 are allowable over the art of record.

Rejections Under 35 U.S.C. § 103(a) of Dependent Claims 19-35, 37, and 38

The Examiner rejected dependent claims 20, 21, 32-34, and 37 for being unpatentable under 35 U.S.C. § 103(a) over Lilja et al. in view of Chen et al. and, in addition, rejected dependent claims 22, 23, 24-31, 35, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Lilja et al. in view of Chen et al. and further in view of Li et al. Notwithstanding any teachings of Lilja et al., Chen et al., or Li et al. relative to the subject matter recited in dependent claims 19-35, 37, and 38, these pending claims depend on independent claims 17 or 36 and are therefore allowable for at least the same reasons discussed above with reference to the pending 35 U.S.C. § 103(a) rejections of these independent claims.

Conclusion

The preceding remarks are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of the application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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